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Dated: May 12, 2008
Signature: Donna Dobson
(Donna Dobson)

Docket No.: 61135/P016US/10106022
(PATENT)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Patent Application of:
Martin J. Pagel

Application No.: 09/469,561

Confirmation No.: 5104

Filed: December 22, 1999

Art Unit: 3639

For: POSTAL PRINTER DRIVER SYSTEM AND METHOD

Examiner: R. Wu

## APPEAL BRIEF

MS Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

As required under 37 C.F.R. § 41.37(a), this brief is filed within two months of the Notice of Appeal filed in this case on March 11, 2008, and is in furtherance of said Notice of Appeal.

The fees required under 37 C.F.R. § 41.20(b)(2) will be dealt with online by credit card.

This brief contains items under the following headings as required by 37 C.F.R. § 41.37 and M.P.E.P. § 1205:

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## I. REAL PARTY IN INTEREST

The real party in interest for this appeal is:

Stamps.com Inc.
12959 Coral Tree Place
Los Angeles, CA 90066-7020

## II. RELATED APPEALS AND INTERFERENCES

There are no other appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in this appeal.

## III. STATUS OF CLAIMS

### A. Total Number of Claims in Application

There are 44 claims pending in application.

### B. Current Status of Claims

1. Claims canceled: 5, 15, 20, 28, 29, 35, 36;
2. Claims withdrawn from consideration but not canceled: none;
3. Claims pending: 1-4, 6-14, 16-19, 21-27, 30-34, and 37-51;
4. Claims allowed: none; and
5. Claims rejected: 1-4, 6-14, 16-19, 21-27 30-34, and 37-51.

### C. Claims On Appeal

The claims on appeal are claims 1-4, 6-14, 16-19, 21-27, 30-34, and 37-51.

## IV. STATUS OF AMENDMENTS

Applicant did not file an Amendment After Final Rejection.

## V. SUMMARY OF CLAIMED SUBJECT MATTER

The following provides a concise explanation of the subject matter defined in each independent claim involved in the appeal, referring to the specification by page and line number and to the drawings by reference characters, as required by 37 C.F.R. § 41.37(c)(1)(v). Each element of the claims is identified by a corresponding reference to the specification and drawings where applicable. However, the citation to passages in the specification and drawings does not imply that the limitations from the specification and drawings should be read into the corresponding claim element.

According to independent claim 1, the subject matter is a method of printing (e.g. page 10, line 26 – page 11, line 11, Fig. 5) a data stream being presented to a printer (e.g. page 10, lines 26 – 27, item 501, Fig. 5, item 20, Fig. 1, Fig. 2). The data stream is adapted to enable the printer to print on one or more sheets of paper information in accordance with the data stream (e.g. page 4, lines 1 – 11). The data stream contains data bits useful for controlling functions additional to the printing information in accordance with the data stream (e.g. page 4, lines 1 – 11). The method of claim 1 comprises abstracting at least a portion of the data bits from the data stream with a postal printer driver. (e.g. page 4, lines 9 – 11; page 11, lines 5 – 11, items 503, 508 – 511, page 11, line 18 – page 12, line 2, page 12, lines 22 - 27, page 9, line 17 – page 10, line 5. Here, the data stream is provided by an application which has not been adapted to control the additional functions and the abstracting includes examining the data stream for data patterns native to the output of the application (e.g. page 5, lines 18 – 26, page 10, lines 12 – 16, page 12, lines 9 – 23). The method of claim 1 also includes using at least some of the abstracted data bits for controlling at least one of the additional functions (e.g. page 12, lines 18 – 27). This additional function includes printing of a postage indicia (e.g. page 13, lines 3 – 14, page 9, lines 17 – 27, page 10, lines 19 - 21). The method of claim 1 further includes creating, from the abstracted data bits, a separate data stream for controlling the printing of the postage indicia (e.g. page 9, lines 17 – 27).

According to independent claim 17, the subject matter is a method of printing (e.g. page 10, line 26 – page 11, line 11, Fig. 5) a data stream being presented to a printer (e.g. page 10, lines 26 – 27, item 501, Fig. 5, item 20, Fig. 1, Fig. 2). The data stream is adapted to enable the printer to print on one or more sheets of paper information in accordance with the data stream (e.g. page 4, lines 1 – 11). Also, the data stream contains data bits useful for

controlling functions additional to the printing information in accordance with the data stream (e.g. page 4, lines 1 – 11. The method of claim 17 comprises abstracting at least a portion of the data bits from the data stream (e.g. page 4, lines 9 – 11; page 11, lines 5 – 11, items 503, 508 – 511, page 11, line 18 – page 12, line 2, page 12, lines 22 - 27, page 9, line 17 – page 10, line 5). The method also includes using at least some of the abstracted data bits for controlling at least one of the additional functions (e.g. page 12, lines 18 – 27), wherein the at least one of the additional functions includes printing of a postage indicia. The method further includes creating, from the abstracted data bits, a separate data stream for controlling the printing of the postage indicia (e.g. page 9, lines 17 – 27). The printer driver is operable on the data stream coming from a program operating in a computing device to control at least a portion of the printing of the printer (e.g. page 11, lines 5 – 26). The abstracting includes examining the data stream for preestablished data patterns (e.g. page 12, lines 9 – 23). The preestablished data patterns include the beginning and ending of postage indicia data (e.g. page 12, lines 9 – 23).

According to independent claim 23 , the subject matter is a method of printing information on a printed document (e.g. page 10, line 26 – page 11, line 11, Fig. 5). The method comprises sending a data stream to a printing device (e.g. page 10, lines 26 – 27, item 501, Fig. 5, item 20, Fig. 1, Fig. 2). The method also includes reviewing the data stream to create therefrom a separate data stream for controlling additional functions with respect to printing of documents (e.g. page 11, lines 5 – 11, items 503, 508 – 511, page 11, line 18 – page 12, line 2, page 12, lines 22 - 27, page 9, line 17 – page 10, line 5). The separate data stream includes data accepted from a source other than the data stream to the printing device (e.g. page 10, lines 16 – 21). The method further includes maintaining in a secure memory an amount available for controlling the generation of a postage indicia and calculating under joint control of the secure memory and the separate data stream an amount of postage to be applied to a particular document to be printed (e.g. page 12, line 22 – page 13, line 4). The method also includes deducting the calculated postage amount from the secure memory if the calculated postage amount is available in the secure memory (e.g. page 9, lines 25 – 27). Further, the method includes printing information from the data stream in accordance with the additional functions.

According to independent claim 33, the claimed subject matter is a computer program product, embodied on a computer-readable medium, for use in association with a data stream being directed to a general purpose printer when executed (e.g. page 10, lines 26 – 27, item 501, Fig. 5, item 20, Fig. 1, Fig. 2). The data stream is adapted to enable the printer to print information in accordance with the data stream (e.g. page 4, lines 1 – 11). The computer program product comprises an abstracting program operable for reviewing the data stream to obtain from the data stream a separate data stream for controlling additional printing operations ancillary to the printing operation (e.g. page 11, lines 5 – 11, items 503, 508 – 511, page 11, line 18 – page 12, line 2, page 12, lines 22 - 27, page 9, line 17 – page 10, line 5). The ancillary operation further includes the acceptance of data from a source other than the data stream (e.g. page 10, lines 16 – 21). The data stream is provided by an application which has not been adapted to control the additional printing operations (e.g. page 5, lines 18 – 26, page 10, lines 12 – 16, page 12, lines 9 – 23). The computer program product also includes a controller working in cooperation with the abstracting program and with the separate data stream for enabling at least the ancillary printing operation (e.g. page 10, lines 16 – 21). This at least one ancillary operation includes the printing of a postage indicia on material separate from material on which printing of the information is occurring (e.g. page 5, lines 7 – 17).

According to independent claim 41, the subject matter is a computer program product, embodied on a computer-readable medium, for use in association with a data stream being directed to a general purpose printer when executed (e.g. page 10, lines 26 – 27, item 501, Fig. 5, item 20, Fig. 1, Fig. 2). The data stream is adapted to enable the printer to print information in accordance with the data stream (e.g. page 4, lines 1 – 11). The computer program product comprises an abstracting program operable for reviewing the data stream to obtain therefrom a separate data stream for controlling additional printing operations ancillary to the printing operation (e.g. page 11, lines 5 – 11, items 503, 508 – 511, page 11, line 18 – page 12, line 2, page 12, lines 22 - 27, page 9, line 17 – page 10, line 5). The computer program product also includes a controller working in cooperation with the abstracting program and with the separate data stream for enabling at least the ancillary printing operation (e.g. page 10, lines 16 – 21). The at least one ancillary operation comprises the printing of a postage indicia on material separate from material on which printing of the information is occurring (e.g. page 5, lines 7 – 17). The abstracting program

includes a control program for examining the data stream for certain preestablished data patterns (e.g. page 12, lines 9 – 23). These preestablished data patterns include the beginning and ending of postage indicia data (e.g. page 12, lines 9 – 23).

## VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

A. Claims 1 – 4, 6 – 14, 16 – 19, 21 – 27, 30 – 34, and 37 – 51 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,684,706 to Harman et al. (hereinafter "Harman").

## VII. ARGUMENT

Claims 1 – 4, 6 – 14, 16 – 19, 21 – 27, 30 – 34 and 37 – 51 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Harman. The Examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness. M.P.E.P. § 2142; *In re Peehs*, 612 F.2d 1287, 204 USPQ 835, 837 (CCPA 1980). In an obviousness rejection, "[u]nder § 103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved." *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 15 – 17 (1966). The claims rejected under 35 U.S.C. § 103(a) in the current application are patentably distinct from the art Appellee cites in the Office Action. The patentability of each rejected claim is discussed below.

### A. Independent Claims 1, 17, 23, 33 and 41

#### 1. Claim 1

Claim 1 recites, "abstracting . . . data bits from said data stream . . . wherein said data stream is provided by an application . . . ." Appellee cites to Harman, col. 3, lines 20 – 24 as teaching this limitation of claim 1. Final Office Action, page 13. Appellee asserts that "an application" is taught by Harman's reference to be Microsoft Word. Further, Appellee asserts that "Figure 2 of Harman's disclosure shows the patterns of the job data 10, outputted by the applications [Microsoft Word], which is parsed by parser 112 residing in the mail production apparatus." Final Office Action, page 14.

Harman does not disclose that Microsoft Word provides job data 10 to parser 112 as Appellee asserts. Instead, Microsoft Word, in Harman, creates document data. Col. 4, lines 40 – 43. "The document data is input to driver 37 and **driver 37 creates the job data by extracting an address from the document data** and accessing data store 38 to define the mail piece attributes . . . ." Col. 4 lines, 43 – 47. Mail center controller 4 then receives this job data and further modifies it by adding data from other sources. Col. 4, lines 35 – 36; Fig. 3 (showing mail center controller combining three data streams to create one data stream). From the explicit disclosure of Harman, Microsoft Word does not provide a data stream to the parser 112—the device in Harman Appellee asserts as abstracting data bits. In other words, the asserted abstracted data bits in Harman is not from a data stream provided by an application.

In response to Appellant's assertions that in Harman Microsoft Word does not provide a data stream to the parser 112, Appellee has contended in the Final Office Action that the modification done by mail center controller 4 is only a disclosure of a preferred embodiment and the postage value could have been determined and included in the job header before the data stream gets to mail center controller 4. Here, Appellee is suggesting that instead of mail center controller 4 modifying the data stream from Microsoft Word, something else modifies the data stream by adding the postage value. Whether or not mail center controller 4 or some other device makes the modification, Harman does not disclose that Microsoft Word provides a data stream to the parser 112—the asserted point of abstraction. Thus, Harman does not teach abstracting data bits from the data stream where the data stream is provided by an application.

With regard to Appellant's assertion that driver 37 modifies the document data from Microsoft Word in Harman, Appellee argues that it would have been obvious to combine the word processing application and driver 37 into one application. Final Office Action, page 3. The asserted combination, however, would be contrary to the requirement of claim 1 that "said data stream is provided by an application which has not been adapted to control said additional functions" because a combination of a Microsoft Word and driver 37 of Harman would clearly be an application adapted to control additional functions.

Claim 1 also recites "said abstracting includes examining said data stream for data patterns native to output of said application . . . ." Appellee cites to Fig. 2 and the parser 112 of Fig. 5 as teaching this limitation of claim 1. Because, as discussed above, the data stream parsed by parser 112 is made up of data from many sources, there is no showing that the parsing that occurs at parser 112 involves examining the data stream for data patterns native to the output of the application. If any examination occurs at Harman's parser 112, it could be an examination of patterns established subsequent to data leaving the Microsoft Word application and prior to parsing by parser 112. In any event, Harman is silent as to whether any examination occurs. Additionally, Harman is silent as to the nature of the examination Appellee asserts occurs at parser 112. Therefore, Harman does not teach abstracting includes examining the data stream for data patterns native to output of the application.

In sum, Harman does not teach all the limitations of claim 1. Accordingly, Appellant respectfully requests that the Board reverse the rejection, under 35 U.S.C. § 103, of claim 1.

2. Claim 17

Claim 17 recites "wherein said abstracting includes examining said data stream for preestablished data patterns, and wherein said preestablished data patterns include the beginning and ending of postage indicia data." Appellee cites to Harman, Fig. 2, col. 6, lines 1 – 3 and col. 4, lines 32 – 33. Final Office Action, page 20. These cited portions of Harman teach that a postage value is appended to mail piece header 18 and that mail piece header 18 is separated by unique separators. Absent from these cited portions of Harman, however, is any teaching that abstracting includes examining the data stream for preestablished data patterns that include the beginning and ending of postage indicia data. Final Office Action, page 9.

Appellee asserts parser 112 carries out the abstraction. But Harman is silent as to whether any examination occurs. Additionally, Harman is silent as to the nature of the purported examination. Appellee therefore has not shown that Harman teaches the limitation of claim 17 reciting "wherein said abstracting includes examining said data stream for preestablished data patterns, and wherein said preestablished data patterns include the beginning and ending of postage indicia data." Accordingly, Appellant respectfully requests that the Board reverse the rejection, under 35 U.S.C. § 103, of claim 17.

3. Claim 23

Claim 23 recites, "calculating under joint control of said secure memory and said separate data stream an amount of postage to be applied to a particular document to be printed . . . ." Appellee cites to Harman, col. 5, lines 56 – 61 as teaching this limitation of claim 23. Final Office Action, page 22. In rejecting claim 23, however, Appellee asserts that "a separate data stream" as recited in claim 23, is Harman's "variable data." *Id.* This variable data, however, is created after the postage value is calculated—the opposite of what Appellee asserts. *See* col. 6, lines 4 – 8 (stating, "Once the postage value is determined . . . class 2 meter . . . returns the variable portion of the indicia to controller 100 . . . Controller 100 downloads this variable data to printer 66 . . . . "). Thus, Appellee's asserted separate data stream does not control calculating an amount of postage to be applied because, in Harman, postage is calculated prior to the asserted separate data stream being created.

In response to Appellant's assertion that postage is calculated prior to the asserted separate data stream being created, Appellee responds that "Harman's invention must be taken as a whole." Final Office Action, page 4. Taking Harman as a whole, however, precludes Appellee from using hindsight reconstruction to pick and choose among isolated disclosures in Harman to deprecate claim 23. *See In re Fritch*, 972 F.2d 1260, 23 USPQ2d 1780, 1783. To argue the variable data controls the amount of postage, though the variable data does not exist when postage is calculated, is to improperly piece together portions of Harman using hindsight.

In sum, Appellee has not shown Harman teaches the limitation of claim 23 reciting, "calculating under joint control of said secure memory and said separate data stream an amount of postage to be applied to a particular document to be printed . . . ." Accordingly, Appellant respectfully requests that the Board reverse the rejection under, 35 U.S.C. § 103, of claim 23.

4. Claim 33

Claim 33 recites, "an abstracting program operable for reviewing said data stream . . . wherein said data stream is provided by an application which has not been adapted to control said additional printing operations . . . ." Appellee cites to Harman, col. 4, lines 35 – 40 as

teaching these limitations of claim 33. Final Office Action, page 25. This cited portion of Harman, however, merely teaches that Microsoft Word provides document data. There is no teaching in the cited portions of Harman that an abstracting program is operable for reviewing this document data. Appellee points to parser 112 as the abstracting program operable for reviewing. *See id.* at page 26. In Harman, parser 112 does not review the document data from Micrsoft Word. The document data from Microsoft Word is combined with other data in processes at driver 37 and mail center controller 4. Col. 4, lines 35 – 36; Fig. 3 (showing mail controller combining three data streams to create one data stream); col. 4, lines 48 – 53; Fig. 3. The product of these processes—job data 10—is then sent to parser 112. Fig. 5; col. 7, lines 48 – 52. Therefore, the asserted reviewing in Harman does not take place on the document data that is provided by an application.

Moreover, because claim 33 requires that the application has not been adapted to control said additional printing operations, the asserted combination of driver 37 and Microsoft Word would not teach an application as recited in the claims. In fact, the combination of driver 37 and Microsoft Word is the opposite of that which is claimed in claim 33. Therefore, Appellee has not shown that Harman teaches the limitation of claim 33 requiring "an abstracting program operable for reviewing said data stream . . . wherein said data stream is provided by an application which has not been adapted to control said additional printing operations . . . ." Accordingly, Appellant respectfully requests that the Board reverse the rejection, under 35 U.S.C. § 103, of claim 33.

5. Claim 41

Claim 41 requires, "wherein said abstracting program includes a control program for examining said data stream for certain preestablished data patterns, and wherein said certain preestablished data patterns include the beginning and ending of postage indicia data." Appellee cites to Harman, Fig. 2, col. 6, lines 1 – 3 and col. 4, lines 32 – 33. *Id.* After citing these portions of Harman, Appellee then concludes, "it is clear that the preestablished data patterns include the beginning and ending of postage indicia." Final Office Action, page 29. It should be noted, however, that the claim does not simply require the existence of beginning and ending of postage indicia data. Claim 41 requires an abstracting program which **examines** the data stream for the beginning and ending of postage indicia data. Thus,

Appellee has not shown Harman teaches this limitation of claim 41 merely by asserting that data in Harman have data patterns.

Claim 41 requires a "separate data stream for enabling at least one said ancillary printing operation, wherein said at least one ancillary operation comprises the printing of a postage indicia . . . ." Appellee cites to Harman col. 5, lines 55 – 50 as teaching this limitation of claim 41 and asserts that the disclosed variable data is a separate data stream as recited in the claim. Final Office Action, page 28. This variable data, however, is created after the postage value is calculated—the opposite of what Appellee asserts. *See* col. 6, lines 4 – 8 (stating, "Once the postage value is determined . . . class 2 meter . . . returns the variable portion of the indicia to controller 100 . . . Controller 100 downloads this variable data to printer 66 . . . . ").

Thus, Appellee's asserted separate data stream does not control calculating an amount of postage to be applied because, in Harman, postage is calculated prior to the asserted separate data stream being created. Appellee, therefore has not shown the limitation of claim 41 requiring a "separate data stream for enabling at least one said ancillary printing operation, wherein said at least one ancillary operation comprises the printing of a postage indicia . . . ." Because Appellee has not shown Harman teaches all the limitations of claim 41, Appellant respectfully requests that the Board reverse the rejection, under 35 U.S.C. § 103, of claim 41.

B. The Dependent Claims 2 – 4, 6 – 14, 16, 18 – 19, 21 – 22, and 47

Claims 2 – 4, 6 – 14, 16, 18 – 19, 21 – 22, and 47 depend from claim 1; claims 24 – 27, and 30 – 32 depend from claim 23; and claims 34, 37 – 40, and 42 – 46 depend from claim 33. As discussed above, claims 1, 23 and 33 are patentable over the applied art. The dependent claims inherit all the limitations from their respective independent claims. For at least this reason, claims 2 – 4, 6 – 14, 16, 18 – 19, 21 – 22, 24 – 27, 30 – 32, 34, 37 – 40, and 42 – 47 are patentable over the applied art. Moreover, the dependent claims themselves recite new and unobvious limitations that are not taught in the applied art.

1. Claim 4

Claim 4 recites "wherein said at least one additional function further comprises a dialog box for allowing options from a user." Appellee concedes that "Harman does not expressly disclose a dialog box for allowing options from a user." Final Office Action, page 15. Appellee then asserts that this limitation is obvious because Harman teaches that controller 4 goes to an error routine if no capable apparatus is found in controller 4. This conclusion of obviousness, however, is inconsistent with *Graham*. As pointed out in *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S.____ (2007), "there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness."

In the Final Office Action, Appellee asserts it would have been obvious to display a dialog box "to notify the user of options such as check the apparatus or switch apparatus." Final Office Action, page 16. Appellee makes this assertion even though the error routine, to which Appellee points, is activated when "no capable apparatus is found . . . ." *See* col. 9, lines 55 – 62. There is no articulated reasoning for giving the user an option to switch apparatus if no capable apparatus exists.

Moreover, in asserting that it is obvious to display a dialog box to check the apparatus, Appellee is merely piecing together alleged teachings from unspecified sources to deprecate the claimed invention. *See In re Fritch*, 23 USPQ2d at 1784 (prohibiting the use of "hindsight reconstruction to pick and choose among isolated disclosures . . . to deprecate the claimed invention"); *Panduit Corp. v. Dennison Mfg. Co.*, 1 USPQ2d 1593, 1595 – 96 (Fed. Cir.), *cert. denied*, 481 U.S. 1052 (requiring that the claimed invention must be considered "as a whole"). Appellee, therefore, has not shown that claim 4 is obvious.

2. Claim 6

Claim 6 recites, "wherein said at least one additional function further comprises directing the abstracted portion to multiple locations." The Board should note that claim 6 requires "directing the abstracted portion to multiple locations." (emphasis added). In asserting Harman teaches this limitation of claim 6, Appellee relies on the parser outputting document data to page description language interpreter and envelope data to envelope data buffer. Final Office Action, page 16. However, if either the document data or the envelope

data is considered the abstracted portion, there is no showing in Harman that these data are sent to multiple locations. Rather, each set of data is sent to a single location—the page description language interpreter **or** envelope data buffer. Appellee, therefore, has not shown Harman teaches at least one additional function further comprises directing the abstracted portion to multiple locations as recited in claim 6.

3. Claim 12

Claim 12 recites, "wherein said printer driver is operable on said data stream coming from said application . . . ." Appellee relies on col. 5, lines 42 – 46 as teaching this limitation of claim 12. Final Office Action, pages 18. Appellee asserts, "mail finishing unit controller 100 stores mail piece attributes 40 from header 12 for default control of the production of each mail piece and downloads common elements of the address to be printed on the envelopes to envelope printer 66." *Id.* However, mail finishing controller 100 receives its data from printer controller 58 after printer controller 58 parses job data and sends the products of the parsing to different locations. *See* col. 5, lines 37 – 46. The downloading of elements of the address from mail finishing unit controller 100, therefore, does not teach the printer driver is operable on the data stream coming from the application.

In response to the foregoing argument, Appellee responds that the printer controller 58 is the printer driver of claim 12. In claim 1, from which claim 12 depends, however, Appellee seems to assert that parser 112 is the printer driver. Appellee did not assert printer controller as the printer driver with regard to claim 1. This anomaly illustrates the distinction between claim 12 and Harman and that Appellee has not considered Harman as a whole. In sum, Appellee has not shown that Harman meets the structure expressly set forth in claim 12.

4. Claim 21

Claim 21 requires that the abstracting of data bits includes examining the data stream for data patterns including the beginning and ending of each document. Appellee cites to "Fig 2, document data field 20" as teaching this limitation of claim 21. Final Office Action, page 21. Appellant asserts that "Hartman discloses, with respect to Fig. 2 that document data 20 is mail piece data defining a sequence of document pages to be printed by the document printer and is separated from other data bits by separators 26-2 and 26-3." Final

Office Action, page 8. In asserting that there are separators between the documents, however, does not teach the requirement that the abstracting of data bits includes examining the data stream for data patterns including the beginning and ending of each document.

5. Claim 22

Claim 22 recites, "wherein said data patterns include the number of pages of a document." The Appellee cites to column 3, lines 57-60, of Harman as teaching this limitation of claim 22. Final Office Action, page 21. However, the cited portion of Harman merely teaches that job header 12 includes the number of document sheets to be accumulated for each mail piece. Absent from this citation is any teaching that the abstracting of data bits includes examining the data stream for the number of pages of a document. Therefore, the Appellee has not shown that Harman teaches all the limitations of claim 22.

6. Claim 25

In rejecting claim 25, Appellee relies upon Harman column 5, lines 42-45, as teaching copying from the data stream portions of the data stream. Final Office Action, pages 12 – 13. The identified portion of Harman, however, teaches mail finishing unit controller stores mail piece attributes and downloads common elements of the address to be printed. Assuming, *arguendo*, that this is copying, the teaching is that the data stream sent to the mail finishing controller is attribute data that has been parsed from the job data by controller 58. *See* col. 5, lines 37 – 46. Thus, the mail finishing unit could only copy the parsed attribute data and has no opportunity to copy the data stream. In other words, considering the invention as a whole, the data stream copied in Harman is not the data stream copied in claim 25. Therefore, Appellee has not shown that Harman teaches all the limitations of claim 25.

7. Claim 26

Claim 26 requires copying portions of said data stream including address information with respect to a particular document to be printed. The Appellee cites to Harman col. 5, lines 42-45, as teaching this limitation of claim 26. Final Office Action, page 23. However, as discussed above, this citation teaches that the asserted copying occurs from the parsed attribute data and not the data stream. Thus, Appellee has not shown Harman teaches the limitations of claim 26.

8. Claim 27

Claim 27 requires creating, from the copied address information, a postage indicia. The Appellee cites to Harman column 6, lines 9-15, as teaching this limitation of claim 27, Final Office Action at page 23. In the cited portion of Harman, however, the controller downloads the address to the printer and the printer then franks the mail piece with postage indicia. There is no teaching here that the postage indicia is created from copied address information. In fact, the franking in Harman produces postage indicia that only contain standard postage indicia imprints. Col. 6, lines 9 – 15. Harman's postage indicia do not include address information. In contrast, in claim 27, the postage indicia include address information. Thus, the Appellee has not shown Harman teaches creating, from the copied address information, a postage indicia as required by claim 27.

9. Claims 31 and 32

Claim 31 recites, "wherein said reviewing step includes the step of enabling a dialog box." Claim 32 recites, "wherein said dialog box interacts with a user to provide at least one of the following . . . ." In rejecting claims 31 and 32, Appellee concedes that "Harman does not expressly disclose the method of claim 23 wherein said reviewing step includes the step of enabling a dialog box and wherein said dialog box interacts with a user to provide . . . ." Final Office Action, page 24. Appellee asserts it would have been obvious to display a dialog box "to notify the user of options such as check the apparatus or switch apparatus." *Id.* Appellee makes this assertion even though the error routine, to which Appellee points, is activated when "no capable apparatus is found . . . ." *See* col. 9, lines 55 – 62. There is no reason, therefore, for giving the user an option to switch apparatus if no capable apparatus exists.

Moreover, in asserting that it is obvious to display a dialog box to check the apparatus, Appellee is merely piecing together alleged teachings from unspecified sources to deprecate the claimed invention. *See In re Fritch*, 23 USPQ2d at 1784 (prohibiting the use of "hindsight reconstruction to pick and choose among isolated disclosures . . . to deprecate the claimed invention."); *Panduit Corp. v. Dennison Mfg. Co.*, 1 USPQ2d 1593, 1595 – 96 (Fed. Cir.), *cert. denied*, 481 U.S. 1052 (requiring that the claimed invention must be considered

"as a whole"). The obviousness rejections of claims 31 and 32 are not proper under *Graham*.

10. Claim 40

Claim 40 recites, "a control program for examining said data stream for certain preestablished data patterns, wherein said control program examines said data stream for data patterns native to output of said application." In rejecting claim 40, Appellee states "Figure 2 of Harman's disclosure shows the patterns of the job data 10, outputted by the applications, which is parsed by parser 112 residing in the mail production apparatus. (Fig 5)." Final Office Action, page 28. Appellee further argues combining Microsoft Word and driver 37 in the rejection of claim 40. Final Office Action, page 10.

Appellee, however, has not shown that a control program pertaining to parser 112 examines the data stream for data patterns native to output of the application. It should be noted that mail center controller 4 has modified the job data that goes to parser 112. *See* col. 3, lines 25 – 29. Moreover, driver 37 generates job data 10 from two sources— (1) document data originating from a word processing application 30 and (2) data from data store 38. Fig. 3, Col. 4, lines 35 –47; col. 5, lines 37 – 42. Appellee, therefore, has not shown that Harman teaches the limitation "a control program for examining said data stream for certain preestablished data patterns, wherein said control program examines said data stream for data patterns native to output of said application."

With regard to the asserted combination of Microsoft Word and driver 37, this would be in contradiction to the limitation of claim 40 (recited in claim 33) that requires "wherein said data stream is provided by an application which has not been adapted to control said additional printing operations . . . ." In sum, Appellee has not shown that Harman teaches all the limitations of claim 40.

11. Claim 45

Claim 45 requires that a computer product includes a control program for examining the data stream for preestablished data patterns that include the beginning and ending of each document to be printed. Appellee cites to Harman, col. 4, lines 18 – 20 and Fig. 2 as teaching

the limitations of claim 45. Final Office Action, page 30. However, the cited portions of Harman teach the "[d]ocument data 20 is mail piece data defining a sequence of document pages to be printed by the document printer . . . ." *Id.* This does not teach that a computer product includes a control program for examining the data stream for preestablished data patterns that include the beginning and ending of each document to be printed.

12. Summary

In sum, Appellee has not shown that dependent claims 2 – 4, 6 – 14, 16, 18 – 19, 21 – 22, 24 – 27, 30 – 32, 34, 37 – 40, and 42 – 47 are obvious in view of Harman. Accordingly, Appellant respectfully requests that the Board reverse the rejections, under 35 U.S.C. § 103, of claims 2 – 4, 6 – 14, 16, 18 – 19, 21 – 22, 24 – 27, 30 – 32, 34, 37 – 40, and 42 – 47.

## VIII. Conclusion

Appellants have shown that claims 1 – 4, 6 – 14, 16 – 19, 21 – 27, 30 – 34 and 37 – 51 are patentable over the rejections of record. As such, Appellant respectfully request that the Board reverse these rejections, under 35 U.S.C. § 103.

## IX. CLAIMS APPENDIX

A copy of the claims involved in the present appeal is attached hereto as Claims Appendix.

## X. EVIDENCE APPENDIX

An Evidence Appendix is attached. However, the Evidence Appendix does not contain any evidence pursuant to 37 C.F.R. §§ 1.130, 1.131, or 1.132 or entered by or relied upon by the Appellee.

## XI. RELATED PROCEEDINGS APPENDIX

A Related Proceedings Appendix is attached. However, the Related Proceedings Appendix does not contain any related proceedings.

Dated: May 8, 2008

Respectfully submitted,

By _____

R. Ross Viguet
Registration No.: 42,203
FULBRIGHT & JAWORSKI L.L.P.
2200 Ross Avenue, Suite 2800
Dallas, Texas 75201-2784
(214) 855-8185
(214) 855-8200 (Fax)
Attorney for Appellant

## CLAIMS APPENDIX

1. A method of printing a data stream being presented to a printer, said data stream adapted to enable said printer to print on one or more sheets of paper information in accordance with said data stream, said data stream containing data bits useful for controlling functions additional to said printing information in accordance with said data stream, said method comprising:

abstracting at least a portion of said data bits from said data stream with a postal printer driver, wherein said data stream is provided by an application which has not been adapted to control said additional functions and said abstracting includes examining said data stream for data patterns native to output of said application;

using at least some of said abstracted data bits for controlling at least one of said additional functions, wherein said at least one of said additional functions comprises printing of a postage indicia; and

creating, from said abstracted data bits, a separate data stream for controlling the printing of said postage indicia.

2. The method claim 1 wherein said at least one additional function further comprises printing of address information on material separate from said printing information in accordance with said data stream.

3. The method of claim 1 wherein said at least one additional function further comprises the printing of a postage indicia on material separate from said printing information in accordance with said data stream.

4. The method of claim 1 wherein said at least one additional function further comprises a dialog box for allowing options from a user.

6. The method of claim 1 wherein said at least one additional function further comprises directing the abstracted portion to multiple locations.

7. The method of claim 1 wherein said at least one additional function further comprises storage in a memory.

8. The method of claim 1 wherein said at least one additional function further comprises directing the abstracted portion to a viewable medium.

9. The method of claim 1 wherein said at least one additional function further comprises the changing of form of the data.

10. The method of claim 1 wherein said at least one additional function further comprises the delivery of said data to a location remote from said printer driver.

11. The method of claim 1 wherein said at least one additional function further comprises the change in at least one of location and format of the data based upon an interaction between certain data in said data stream and data stored in said printer driver.

12. The method of claim 1 wherein said printer driver is operable on said data stream coming from said application operating in a computing device to control at least a portion of the printing of said printer.

13. The method of claim 12 wherein said printer driver is located remote from said computing device.

14. The method of claim 12 wherein said printer driver is located within said printer.

16. The method of claim 1 wherein said data patterns are selected from the list including:

return address, destination address, mailing date, number of pages, type of inserts, mailing service type, postage indicia, bar codes, tracking codes, control codes, graphics, application types.

17. A method of printing a data stream being presented to a printer, said data stream adapted to enable said printer to print on one or more sheets of paper information in accordance with said data stream, said data stream containing data bits useful for controlling functions additional to said printing information in accordance with said data stream, said method comprising:

abstracting at least a portion of said data bits from said data stream;

using at least some of said abstracted data bits for controlling at least one of said

additional functions, wherein said at least one of said additional functions comprises printing of a postage indicia; and

creating, from said abstracted data bits, a separate data stream for controlling the printing of said postage indicia;

wherein said printer driver is operable on said data stream coming from a program operating in a computing device to control at least a portion of the printing of said printer, wherein said abstracting includes examining said data stream for preestablished data patterns, and wherein said preestablished data patterns include the beginning and ending of postage indicia data.

18. The method of claim 1 wherein said additional function further comprises the printing of said postage indicia on a document other than the document to which said data stream is being directed.

19. The method of claim 1 wherein said data patterns include the beginning and ending of address information contained within said data stream.

21. The method of claim 1 wherein said data patterns include the beginning and ending of each document to be printed.

22. The method of claim 1 wherein said data patterns include the number of pages of a document.

23. A method of printing information on a printed document, said method comprising the steps of:

sending a data stream to a printing device;

reviewing said data stream to create therefrom a separate data stream for controlling additional functions with respect to printing of documents, wherein said separate data stream includes data accepted from a source other than said data stream to said printing device;

maintaining in a secure memory an amount available for controlling the generation of a postage indicia;

calculating under joint control of said secure memory and said separate data stream an amount of postage to be applied to a particular document to be printed;

deducting said calculated postage amount from said secure memory if said calculated

postage amount is available in said secure memory; and

printing information from said data stream in accordance with said additional functions.

24. The method of claim 23 wherein said additional functions are selected from the list including printing address information, printing postage indicia, folding a printed document, stuffing a printed document into an envelope, creating a mailing address for the delivery of a printed document, creating a postage indicia, creating an auxiliary document in association with a printed document, controlling a second printer operating in conjunction with said printer, verifying the address, normalizing the address, adding delivery bar codes.

25. The method of claim 23 wherein said reviewing step includes the step of:

copying from said data stream portions of said data stream.

26. The method of claim 25 wherein said portions include address information with respect to a particular document to be printed.

27. The method of claim 26 further including the step of:

creating from said copied address information a postage indicia.

30. The method of claim 25 wherein said portions include postage indicia information with respect to a particular document to be printed.

31. The method of claim 23 wherein said reviewing step includes the step of enabling a dialog box.

32. The method of claim 31 wherein said dialog box interacts with a user to provide at least one of the following:

return address and logo;

date of mailing;

address verification/prompt for insufficient information;

review scanned data;

hints for scanning data stream;

additional cover page information or label/envelope customization;

delivery (mail service, fax, e-mail, etc.) ; and

options (postage amount, paper weight, weight of inserts, additional mail services).

33. A computer program product, embodied on a computer-readable medium, for use in association with a data stream being directed to a general purpose printer when executed, said data stream adapted to enable said printer to print information in accordance with said data stream, said computer program product comprising:

an abstracting program operable for reviewing said data stream to obtain from said data stream a separate data stream for controlling additional printing operations ancillary to said printing operation, wherein said one ancillary operation further comprises the acceptance of data from a source other than said data stream, wherein said data stream is provided by an application which has not been adapted to control said additional printing operations; and

a controller working in cooperation with said abstracting program and with said separate data stream for enabling at least one said ancillary printing operation, wherein said at least one ancillary operation comprises the printing of a postage indicia on material separate from material on which printing of said information is occurring.

34. The computer product of claim 33 wherein said at least one ancillary operation comprises the printing of address information on material separate from material on which printing is occurring.

37. The computer product of claim 33 wherein said computer product is operable on said data stream coming from a general purpose computing device.

38. The computer product of claim 37 wherein said computer product is located remote from said computing device.

39. The computer product of claim 37 wherein said computer product is located within said printer.

40. The computer product of claim 33 wherein said abstracting program includes:

a control program for examining said data stream for certain preestablished data patterns, wherein said control program examines said data stream for data patterns native to output of said application.

41. A computer program product, embodied on a computer-readable medium, for use in association with a data stream being directed to a general purpose printer when executed, said data stream adapted to enable said printer to print information in accordance with said data stream, said computer program product comprising:

an abstracting program operable for reviewing said data stream to obtain therefrom a separate data stream for controlling additional printing operations ancillary to said printing operation; and

a controller working in cooperation with said abstracting program and with said separate data stream for enabling at least one said ancillary printing operation, wherein said at least one ancillary operation comprises the printing of a postage indicia on material separate from material on which printing of said information is occurring;

wherein said abstracting program includes a control program for examining said data stream for certain preestablished data patterns, and wherein said certain preestablished data patterns include the beginning and ending of postage indicia data.

42. The computer product of claim 40 wherein one said ancillary operation comprises the printing of said postage indicia on a document other than the document to which said data stream is being directed.

43. The computer product of claim 40 wherein said certain preestablished data patterns include the beginning and ending of address information contained within said data stream.

44. The computer product of claim 43 wherein said computer product further contains:

a program for creating from said address information data for controlling the printing of a postage indicia.

45. The computer product of claim 43 wherein said certain preestablished data patterns include the beginning and ending of each document to be printed.

46. The computer product of claim 40 wherein said data patterns are selected from the list including:

return address, destination address, mailing date, number of pages, type of inserts, mailing service type, postage indicia, bar codes, tracking codes, control codes.

47. The method of claim 1, wherein said at least one additional function further comprises accepting data from a source other than said data stream.

48. The method of claim 1 further comprising:
controlling the abstraction from said data stream by a code embedded in said data stream.

49. The method of claim 17 further comprising:
controlling the abstraction from said data stream by a code embedded in said data.

50. The computer program product of claim 33 wherein said abstraction program is controlled by a code embedded in said data stream.

51. The computer program product of claim 41 wherein said abstraction program is controlled by a code embedded in said data stream.

## EVIDENCE APPENDIX

No evidence pursuant to §§ 1.130, 1.131, or 1.132 or entered by or relied upon by the Appellee is being submitted.

## RELATED PROCEEDINGS APPENDIX

No related proceedings are referenced in II. above, hence there are no copies of decisions in related proceedings to be provided.